

REMARKS

These Remarks are responsive to the Office Action mailed September 27, 2004, (“Office Action”). As an initial matter, applicants note that claims 21-47 are pending in the instant application. Claims 1-20 were cancelled by preliminary amendment filed with the original application on December 18, 2001. Accordingly, applicants interpret references in the Office Action to claims 1-40 to actually refer to pending claims 21-40.

The Office Action asserts that this application claims two distinct inventions. Claims 21-40 (Group I) are deemed drawn to a method of reducing reflected lightglare into a human’s eyes from the human’s cheeks. Claims 41-47 (Group II) are deemed drawn to an eye black. Restriction is required between the inventions of Group I and Group II. Applicants traverse this requirement as the Office Action fails to demonstrate that the designated groups are directed to distinct inventions.

The Office Action asserts that the inventions of Groups II and I are related as product and process of use, respectively. Applicants disagree. Claims 21-40 (Group I) are directed to methods of reducing light glare including a step of applying underneath the eye a material comprising a decal or a temporary tattoo. Claims 41-47 (Group II) are directed to an eye black produced by a method including a step of applying underneath the eye a material, wherein the application is practiced by placing a stencil underneath the eye. Group I is directed to the use of decals and temporary tattoos. Group II is directed to the use of stencils. These claims are not related as product and process of use as asserted in the Office Action.

The Office Action asserts that the eye black of Group II can be applied to any surface to which a shaped, non-reflective material is desired. This is incorrect. Claim 41 expressly sets forth an eye black produced by “applying underneath a human’s eyes, on the human’s cheeks, generally covering a location at which incident direct or indirect light is likely to be reflected in the human’s eyes, a non-toxic material.” Claims 42-47 depend from claim 41 and, thus, include each limitation of claim 41. The eye black of Group II, thus, cannot be applied to any surface as asserted in the Office Action. The eye black of Group II *as claimed* is not distinct from Group I based on where the eye black can be applied as is asserted in the Office Action.

For the above reasons, applicants respectfully submit that the Office Action fails to demonstrate that the claims of Group I claim a distinct invention from the claims of Group II. Accordingly, applicants request the withdrawal of the restriction requirement. Should the requirement not be withdrawn, applicants provisionally elect claims 21-40 (Group I) for examination.

Dated: October 27, 2004

Respectfully submitted,

HUNTON & WILLIAMS LLP

By:



Thomas J. Scott, Jr.
Registration No 27,836

Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)